

GROUP ART UNIT: 1774
APPEAL NO.

#10
10-14-03
D81

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

APPELLANT'S BRIEF

Barrett Richard Bobsein

Application for Patent Filed June 14, 2001

Serial No. 09/880,996

THERMOSENSITIVE RECORDING MATERIAL

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Ronald D. Bakule
Agent for Appellant

B.H. Hess
Examiner

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

DN A01196

In re application of
Barrett Richard Bobsein

Paper No.: 10

Serial No. 09/880,996

Group Art Unit: 1774

Filed: June 14, 2001

Examiner: B.H. Hess

For: THERMOSENSITIVE RECORDING MATERIAL

Commissioner for Patents
Box 1450
Alexandria, VA 22313-1450

BRIEF FOR APPELLANT

This is an appeal from the final rejection by the Examiner of May 5, 2003 rejecting claims 1-2. Appellant filed a Notice of Appeal pursuant to 37 C.F.R. 1.191 on August 5, 2003.

An authorization to charge payment of the fee for the filing of the Appeal Brief to Deposit Account 18-1850 is also enclosed.

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REAL PARTY IN INTEREST [37 C.F.R. 1.192(c)(1)]

The real party in interest is Rohm and Haas Company, 100 Independence Mall West, Philadelphia, PA 19106-2399.

RELATED APPEALS AND INTERFERENCES [37 C.F.R. 1.192(c)(2)]

There are no other related appeals or interferences that will directly affect or be directly affected or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS [37 C.F.R. 1.192(c)(3)]

The status of the claims is as follows:

Allowed claims	-	none
Claims objected to	-	none
Claims cancelled	-	none
Claims pending	-	1-2
Claims rejected	-	1-2
Claims on appeal	-	1-2

STATUS OF AMENDMENTS [37 C.F.R. 1.192(c)(4)]

The rejected claims are set out in Appendix 1.

SUMMARY OF INVENTION [37 C.F.R. 1.192(c)(5)]

Appellant claims (claims 1-2) a thermosensitive recording material comprising
a support bearing thereon

a first layer comprising multivoided particles, said particles having been formed by (i) a core-shell emulsion polymerization process, said core comprising a copolymerized ester functional group monomer, (ii) hydrolyzing said monomer subsequent to or during the formation of said shell, (iii) treating said core with base concurrently with or subsequently to said

hydrolysis to swell said particle and (iv) forming multiple voids within said particle when dried, and,

disposed on said first layer, a thermosensitive recording layer.

ISSUES [37 C.F.R. 1.192(c)(6)]

The issue is whether appellant's invention of claims 1-2 is unpatentable under 35 USC 103(a) over US Patent No. 5,409,881 to Mori, et al. ("Mori").

THE REJECTIONS

Claims 1-2 stand finally rejected under 35 USC 103(a) as being unpatentable over Mori.

The Examiner's Arguments

The Examiner asserts that claims 1-2 are unpatentable under 35 USC 103(a) over Mori because Mori teaches a thermosensitive recording material wherein a multivoided particle layer formed by a core-shell polymerization process is coated onto a support prior to application of the thermosensitive layers.

GROUPING OF CLAIMS [37 C.F.R. 1.192(c)(7)]

As to the rejection applied against claims 1-2 under 35 USC 103(a), it is appellant's intention that the rejected claims stand or fall together.

ARGUMENTS [37 C.F.R. 1.192(c)(8)]

The examiner rejected claims 1-2 under 35 USC 103(a) as being unpatentable over Mori. Mori discloses a thermosensitive paper including optional back coating, undercoating, and protective layer, each of which may have the same composition. More specifically, Mori discloses (Mori, column 13, lines 8-12) an optional intermediate layer interposed between the support

and the thermosensitive recording layer “comprising as the main component expanded plastic minute void particles” (underlining added). Appellant submits that Mori thereby suggests to one skilled in the art thermoplastic polymer particles which include minute inclusions of “blowing agents” which can be “expanded” to form “minute voids”. Mori further characterizes the particles (Mori, column 13, lines 13-21) by stating that “In the above-mentioned expanded plastic minute void particles for use in the intermediate layer, air or other gases are contained in a shell comprising a thermoplastic resin such as ...”. Appellant respectfully submits that Mori describes particles containing minute voids within a thermoplastic matrix formed by expanding agents within the formed particles to form the voids. Mori’s sole example of an intermediate layer, Example 21, discloses the use of “Expanded plastic minute particles” without indicating their source, characterization, or method of synthesis. Appellant respectfully submits that Mori certainly does not teach or suggest a first layer disposed on a substrate including multivoided particles, the particles having been formed by (i) a core-shell emulsion polymerization process, the core comprising a copolymerized ester functional group monomer, (ii) hydrolyzing the monomer subsequent to or during the formation of the shell, (iii) treating the core with base concurrently with or subsequently to the hydrolysis to swell the particle and (iv) forming multiple voids within the particle when dried. Nor does Mori enable a structure including a first layer including appellant’s multivoided particles since there is no teaching or suggestion of the formation, actual or inherent, of appellant’s multivoided particles, or the layer including them.

Further, appellant submits that the examiner has pointed to no disclosure within Mori nor motivation from Mori to remove his expanded plastic minute particles from his optional intermediate layer and to replace them with different polymer particles. It would not have been *prima facie* obvious to delete an important element of a structure if such a deletion or

omission would destroy the invention on which the prior art reference is based. Compare *Ex parte Hartmann*, 186 USPQ 366, 367 (Bd. App 1974).

Conclusions

Appellant respectfully submits that the present invention as defined by claims 1-2 was not obvious as a whole to one of ordinary skill in the art at the time the invention was made over Mori under 35 U.S.C. 103(a) because the examiner has not met his burden of establishing a *prima facie* case of obviousness and, in any event, appellant's invention is not taught or suggested therein.

Appellant respectfully requests the Board to reverse the Examiner's rejections and enter a Notice of Allowance. The Commissioner is hereby authorized to charge any additional fee which may be required, or to credit any overpayments to Deposit Account 18-1850.

Respectfully submitted,



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APPENDIX [37 C.F.R. 1.192(c)(9)]

CLAIMS 1-2

1(amended). A thermosensitive recording material comprising a support bearing thereon a first layer comprising multivoided particles, said particles having been formed by (i) a core-shell emulsion polymerization process, said core comprising a copolymerized ester functional group monomer, (ii) hydrolyzing said monomer subsequent to or during the formation of said shell, (iii) treating said core with base concurrently with or subsequently to said hydrolysis to swell said particle and (iv) forming multiple voids within said particle when dried, and, disposed on said first layer, a thermosensitive recording layer.

2(original). The thermosensitive recording material of claim 1 wherein said multivoided particles are polymeric multivoided particles having a diameter from 0.1 micron to 2 microns.

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Dear Sir:

I hereby certify that this Original Appeal Brief and 2 copies are being deposited as First Class Mail with the United States Postal Service in an envelope addressed to the Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450 on the date indicated next to my signature below.

Date *October 4, 2003*

Signature *David D. Baskin*